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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/736,137

12/15/2003

Thomas E. Creamer

BOC9-2003-0093 (464)

3692

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7590

12/10/2008

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EXAMINER

AHMED, SALMAN

ART UNIT

PAPER NUMBER

2419

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/736,137	<b>Applicant(s)</b> CREAMER ET AL.	
	<b>Examiner</b> SALMAN AHMED	<b>Art Unit</b> 2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/15/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

Claims 1-8 are pending.

Claims 1-8 are rejected.

***Response to Arguments***

4. Applicant's arguments see pages 4-7 of the Remarks section, filed 8/4/2008, with respect to the rejections of the claims have been fully considered and are not persuasive.

The Affidavit filed on 2/12/2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hicks reference.

Applicant argues that the claimed invention was conceived prior to June 6 2003 (see 37 CFR 1.131 affidavit filed on 2/12/2008). In addition to submitting Declarations, Applicant has submitted the followings as supporting documents:

Exhibit A is an email letter, dated September 25, 2003, from Inventor Tom Creamer to IBM in-house counsel with comments regarding search results.

Exhibit B is a letter from an IBM Patent Attorney requesting outside counsel prepare the Application, dated September 25, 2003.

Exhibit C is a letter from outside counsel confirming receipt of the instructions, dated October 2, 2003.

Exhibit D is an email letter from outside counsel requesting review and approval of the Application drafted by outside counsel, dated November 29, 2003.

Exhibit E is an email letter from Inventor Neil Katz, approving the draft Application, dated November 30, 2003.

Exhibit F is an email letter, dated December 1, 2003, from outside counsel requesting review and final approval of the Application, together with Declaration and Power of Attorney and Assignment for the inventors to sign.

Exhibit G is a copy of the Declaration and Power of Attorney signed by the inventors and filed with the Application on December 15, 2003, evidencing the inventors' approval of the application.

However, Examiner respectfully submits that the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hicks reference to either a constructive reduction to practice or an actual reduction to practice for the following reasons:

A: Applicant's submitted Exhibits A is an email letter, dated September 25, 2003, from Inventor Tom Creamer to IBM in-house counsel with comments regarding search results. However, no supporting document has been produced to show due diligence from the date prior to June 6, 2003 (Hicks reference earliest effective filing date) to the Exhibit A email date of September 25, 2003 related to the instant Application. The affidavit must explain how the documents and other evidence establish the facts which are being offered to prove conception, diligence and/or a reduction to practice of the claimed invention. See *In re Borkowski*, 505 F.3d 713, 719, 184 USPQ 29, 33 (CCPA 1974). Conception, diligence, and an actual reduction to practice are legal conclusions.

The Rule 131 Affidavit or declaration must supply sufficient facts to support those conclusions, *In re Clarke*, 356 F.2d 987, 993, 148 USPQ 665, 671 (CCPA 1966).

**B:** MPEP 715 Swearing Back of Reference - Affidavit or Declaration Under 37 CFR 1.131 [R-3] states: (b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

**C:** MPEP 2138.06 "Reasonable Diligence" [R-1] - 2100 Patentability states:

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) ( **37 CFR 1.131** issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be

embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); *Wu v. Jucker*, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); *Tucker v. Natta*, 171 USPQ 494,498 (Bd. Pat. Inter. 1971) ("[a]ctivity directed toward the reduction

to practice of a genus does not establish, prima facie, diligence toward the reduction to practice of a species embraced by said genus"); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course...").

The work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue. *Naber v. Cricchi*, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977), cert. denied, 439 U.S. 826 (1978). >See also *Scott v. Koyama*, 281 F.3d 1243, 1248-49, 61 USPQ2d 1856, 1859 (Fed. Cir. 2002) (Activities directed at building a plant to practice the claimed process of producing tetrafluoroethane on a large scale constituted efforts toward actual reduction to practice, and thus were evidence of diligence. The court distinguished cases where diligence was not found because inventors either discontinued development or failed to complete the invention while pursuing financing or other commercial activity.); *In re Jolley*, 308 F.3d 1317, 1326-27, 64 USPQ2d 1901, 1908-09 (Fed. Cir. 2002) (diligence found based on research and procurement activities related to the subject matter of the interference count).< "[U]nder some circumstances an inventor should also be able to rely on work on closely related inventions as support for diligence toward the reduction to practice on an invention in issue." *Ginos v. Nedelec*, 220 USPQ 831, 836 (Bd. Pat. Inter. 1983)

(work on other closely related compounds that were considered to be part of the same invention and which were included as part of a grandparent application). "The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. It is not sufficient that the activity relied on concerns related subject matter." *Gunn v. Bosch*, 181 USPQ 758, 761 (Bd. Pat. Inter. 1973) (An actual reduction to practice of the invention at issue which occurred when the inventor was working on a different invention "was fortuitous, and not the result of a continuous intent or effort to reduce to practice the invention here in issue. Such fortuitousness is inconsistent with the exercise of diligence toward reduction to practice of that invention." 181 USPQ at 761. Furthermore, evidence drawn towards work on improvement of samples or specimens generally already in use at the time of conception that are but one element of the oscillator circuit of the count does not show diligence towards the construction and testing of the overall combination.); *Broos v. Barton*, 142 F.2d 690, 691, 61 USPQ 447, 448 (CCPA 1944) (preparation of application in U.S. for foreign filing constitutes diligence); *De Solms v. Schoenwald*, 15 USPQ2d 1507 (Bd. Pat. App. & Inter. 1990) (principles of diligence must be given to inventor's circumstances including skill and time; requirement of corroboration applies only to testimony of inventor); *Huelster v. Reiter*, 168 F.2d 542, 78 USPQ 82 (CCPA 1948) (if inventor was not able to make an actual reduction to practice of the invention, he must also show why he was not able to constructively reduce the invention to practice by the filing of an application).

Since no supporting document has been produced to show due diligence from the date prior to June 6, 2003 (Hicks reference earliest effective filing date) to the



Exhibit A email date of September 25, 2003 related to the instant Application Examiner respectfully disagrees with the Applicant's assertion that Hicks is not a valid prior art reference and Examiner further respectfully disagrees with the Applicant's assertion that Hicks cannot be used to render obvious the embodiments of Applicant's present invention as claimed in claims 1-8.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks III (US PAT PUB 2006/0019667) in view of Virtanen et al. (US PAT PUB 2002/0006797, hereinafter Virtanen).

In regards to claims 1 and 8, Hicks teaches a method/means of roaming between mobile and wireless networks comprising: detecting a wireless network in proximity to a mobile device (section 0101, the wireless access point 512 detects the dual mode telephone 106 entering the wireless network from the MAC broadcast by the dual mode telephone 106); querying the wireless network for an Internet Protocol address for the mobile device (section 0101, at block 808, the MAC address is obtained from the broadcast and an IP address is assigned to the handset having the MAC address. Depending upon the connectivity of the wireless access point to the wired data network, the IP address may be assigned at a local router or may be assigned at a remote router of the wired data network); receiving the Internet Protocol address (section 0101, at block 808, the MAC address is obtained from the broadcast and an IP address is assigned to the handset having the MAC address. Depending upon the connectivity of the wireless access point to the wired data network, the IP address may be assigned at a local router or may be assigned at a remote router of the wired data network); and sending a message via a mobile network for the mobile device to a mobile switching center of the mobile network (section 0104, at block 820, the dual mode telephone 106 sends a first message such as, for example, a short message service (SMS) message to the MSC 272 of the licensed wireless network 112 notifying the MSC 272 to route communications directed to the wireless number associated with the dual mode phone 106 to the wired data line number associated with the phone 106), wherein the message instructs the mobile switching center to route voice data intended for the mobile device to the Internet Protocol address via a communicatively linked gateway

and the wireless network (section 0104, At block 824, when a communication directed to the wireless number associated with the dual mode phone 106 is received at the MSC 272, a termination attempt trigger is generated at the MSC. In response thereto, a query is transmitted to the HSS 912 requesting further instructions on the handling of the incoming communication at block 826. Based on the content of the first message stored at the HSS 912, at block 828 the incoming communication is routed to the wired data line number associated with the dual mode phone 106 via the unlicensed wireless network 110 for VoIP communication, such as through the GMSC 250 and MGW 246 from the MSC 272).

In regards to claims 5 and 7 Hicks teaches method/means for communicating over a wireless network using a mobile device (section 0104, the user may send and receive subsequent calls on the dual mode telephone 106 via the cordless mode through the unlicensed wireless network 110), detecting that the mobile device is roaming outside a coverage area of the wireless network (section 0105, at block 834, the dual mode telephone 106 detects the loss of the unlicensed wireless network connectivity); and sending a message via a mobile network for the mobile device to a mobile switching center of the mobile network (section 0105, accordingly, the dual mode phone 106 sends a second message to the MSC 272 of the licensed wireless network 112 notifying the MSC 272 to route communications directed to the wireless number associated with the dual mode phone 106 to the wireless number at block 836), wherein the message instructs the mobile switching center to route voice data intended for the mobile device to the mobile device using at least one mobile voice channel of the

mobile network (section 0105, when a communication directed to the wireless number associated with the dual mode phone 106 is received at the MSC 272, a termination attempt trigger is generated at the MSC 272. In response thereto, a query is transmitted to the HSS 912 requesting further instructions on the handling of the incoming communication. Based on the content of the second message stored at the HSS 912, the incoming communication is routed to the wireless number associated with the dual mode phone 106 via the licensed wireless network 112 for wireless (mobile) communication).

Hicks does not explicitly teach message being send via control channel.

Virtanen in the same field of endeavor teaches message being send via control channel (section 0069, if, in step 901, the MS finds out that a call is going on, it delivers in step 911 the SM via control channels related to that call).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hicks' system/method by incorporating the steps of message being sent via control channel as suggested by Virtanen. The motivation is that, by utilizing the less used control channel for transmitting messages, a system can efficiently utilize available bandwidth; thus making more efficient usage of network resources.

In regards to claims 5 and 7 Hicks and Virtanen do not explicitly teach transmitting voice using voice channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hicks and Virtanen's system/method by incorporating the

steps of transmitting voice using voice channel, as voice channels are designated in a wireless network to efficiently and reliably transmit voice signals for implementing successful voice communication.

In regards to claim 2 Hicks teaches receiving voice data from the gateway via the wireless network (section 0104).

In regards to claim 3 Hicks teaches configuring the mobile switching center to route voice data intended for the mobile device to the Internet Protocol address via the communicatively linked gateway and the wireless network (section 0104).

In regards to claim 4 Hicks teaches prior to detecting step, the mobile device is in communication with a different wireless network (section 0100).

In regards to claim 6 Hicks teaches receiving voice data from the mobile switching center via the mobile network (section 0105).

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SALMAN AHMED whose telephone number is (571)272-8307. The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. A./

Examiner, Art Unit 2419

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/Edan Orgad/

Supervisory Patent Examiner, Art Unit 2419